

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFF S. VIGIL and MICHAEL J. DETLEF

Appeal 2007-2343
Application 09/928,856
Technology Center 2100

Decided: September 27, 2007

Before JOSEPH F. RUGGIERO, HOWARD B. BLANKENSHIP,
and MAHSHID D. SAADAT, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-3, 7-19, 23-34, and 37-40, which are all of the claims pending in this application, as claims 4-6, 20-22, 35, and 36 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

Appellants invented a hand-held wireless telecommunications device that is configured to send a message to a recipient over a global computer

network wherein a user input component is provided for user input and message entry (Specification 2). An understanding of the invention can be derived from a reading of exemplary independent claim 1 which is reproduced as follows:

1. A hand-held wireless telecommunications device configured to send a text message to a recipient through use of a global computer network, the wireless device comprising:

a processor;

an input component in electronic communication with the processor for a user to enter user input, wherein the input component is capable of entering text;

a display in electronic communication with the processor that displays information to the user;

a communications module in electronic communication with the processor for communicating with the global computer network;

memory in electronic communication with the processor for storing data, wherein the data comprises at least one token;

a messaging module comprising instructions that are executable by the processor for implementing a method comprising:

connecting the wireless device to the global computer network;

displaying network data received from the global computer network on the display;

enabling the user to establish communications with a message web site;

providing to the user a message user interface to select a message from a plurality of preconfigured messages, each of the

plurality of messages being preconfigured to be sent to a recipient, wherein at least one of the messages is a text message that includes at least one token, wherein the messaging module receives the plurality of preconfigured messages from the message web site based on a user identification and displays the message user interface on the display thereby enabling the user to select the message from the plurality of preconfigured messages, and wherein the messaging module allows the user to enter token text to replace the at least one token in the message;

providing to the user a recipient user interface to select the recipient; and

sending the message to the recipient through the global computer network.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Martin	US 2002/0174106 A1	Nov. 21, 2002
Graham	US 2002/0178353 A1	Nov. 28, 2002
Puskala	US 6,908,389 B1	Jun. 21, 2005

The rejections as presented by the Examiner are as follows:

1. Claims 1-3, 7, 8, 13-19, 23, 24, 29-34, and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Puskala and Martin.
2. Claims 9-12, 25-28, and 38-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Puskala, Martin, and Graham.

ISSUES

- (1) Under 35 U.S.C § 103(a), with respect to appealed claims 1-3, 7, 8, 13-19, 23, 24, 29-34, and 37, would one of ordinary skill in the

art at the time of the invention have found it obvious to combine Puskala and Martin to render the claimed invention unpatentable?

- (2) Under 35 U.S.C § 103(a), with respect to appealed claims 9-12, 25-28, and 38-40, would the ordinarily skilled artisan have found it obvious to modify the combination of Puskala and Martin with Graham to render the claimed invention unpatentable?

FINDINGS OF FACT

The following findings of fact (FF) are relevant to the issues involved in the appeal and are believed to be supported by a preponderance of the evidence.

1. Puskala relates to a system and method of communicating between players of games played over a wireless network (col. 1, ll. 7-9).
2. Puskala teaches that predefined messages are sent to at least one of a plurality of preselected destination addresses during the game (col. 2, ll. 11-22).
3. Each predefined message may be defined to comprise at least one of voice, text, sound, an image, a picture, a brief video, and a multimedia message, and may be stored at the first mobile terminal or at a network-based message database accessible to the first mobile terminal (col. 3, ll. 25-29).
4. Puskala allows a player to modify a predefined message or use only the stored predefined messages (col. 7, ll. 16-31).
5. Martin is directed to an apparatus for obtaining information from a user, parsing the input to determine a keyword, determining a

connector based on the keyword, and filing a template in the connector (§ 0008).

6. Martin describes a connector including a template which includes some specific actions/text, and placeholder tokens, for data to be added by the user. Placeholder tokens are the vehicle by which user input and "real time" data and context are transferred from a client to an agent. For one embodiment, placeholder tokens also determine when a connector is selected (§ 0065).

7. Martin further describes tokens and their placement in the text (§§ 0066- 0074). In addition to client or agent filling placeholder tokens with text, Martin teaches that placeholder token may also be filled by the user (§ 0075).

PRINCIPLES OF LAW

To reach a conclusion of obviousness under section 103, the Examiner bears the burden of producing factual basis supported by teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. *In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

Furthermore, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), *In re Young*, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir.

1991) and *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161, 82 USPQ2d 1687, 1691 (Fed. Cir. 2007) (quoting *KSR Int’l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007)). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 127 S. Ct. at 1742, 82 USPQ2d at 1397.

ANALYSIS

1. Rejection of claims 1-3, 7, 8, 13-19, 23, 24, 29-34, and 37 over Puskala and Martin

Appellants mainly argue that Martin’s “placeholder tokens” are not taught nor suggested to be replaced with “token text” entered by the user or edited by the user (Br. 10; Reply Br. 3-6). Appellants rely on paragraphs 0066-0070 of Martin and assert that the “placeholder tokens” are either

specially flagged text replaced by the dispatcher or are “filled with data by the client or agent, which are software modules, but not the same as the claimed “users” (*id.*).

Appellants further contend that one of ordinary skill in the art would not combine Martin’s tokens in Puskala since Puskala’s intention is to prevent interruptions to multi-player gameplay by using entirely predefined messages instead of tokens (Br. 11-16). Appellants argue that Puskala teaches away from entering message text during gameplay because typing on a numeric pad for entering text slows the process and is contrary to the direction the invention of Puskala takes (*id.*).

The Examiner argues that Martin actually allows input from a user on the device (§ 0075-0077), which replaces the placeholder token if more information is needed (Answer 16-17). The Examiner concludes that, contrary to Appellants’ assertion, the user, as well as the client or dispatcher, may enter text to edit the token text (Answer 18). With respect to combinability of Puskala with Martin, the Examiner argues that the same reason Puskala considers predefined messages advantageous during gameplay, makes Martin’s use of tokens in text messaging desirable (Answer 19). The Examiner adds that using tokens further minimizes text editing or entering the entire message when the messages need to be modified and therefore, its combination with predefined messages of Puskala would have been obvious to one of ordinary skill in the art (Answer 19-21).

We agree with the Examiner's position. First, Martin does teach that the placeholder token may be filled with text entered by the user (FF6-7). Second, using placeholder tokens in messaging scheme of Puskala is not contrary to the purpose of minimizing typing messages during the gameplay. Puskala uses predefined messages to minimize interruptions during the game and therefore, when a message needs to be modified, using placeholder tokens taught by Martin minimizes interruptions during a game and further saves time (FF 2-4). Therefore, we also find Appellants' argument (Br. 12-14) that such process, by which only the text corresponding to placeholder token is entered by the user, is in conflict with the teachings of Puskala wherein predefined messages are used to save time, to be unconvincing.

Furthermore, contrary to Appellants' assertion against combinability of the references (Br. 11-16), combining Puskala and Martin is based on common schemes for efficient use of time needed for composing text messages. Puskala generally uses predefined messages, but also allows for modifications made to these messages by the user (FF 3-4). In fact, since Martin, by using placeholder tokens, reduces the number of key entries by the user in completing a form or messages (FF 6-7), one of ordinary skill in the art would have found it obvious to combine the references to benefit from the minimized text entry associated with using placeholder tokens of Martin.

Thus, in light of these findings, we find that the combination of Puskala and Martin suggests the subject matter of Claim 1 as well as claims 2, 3, and 7, 8, 13-19, 23, 24, 29-34, and 37, argued together as one group.

See In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

1. Rejection of claims 9-12, 25-28, and 38-40 over Puskala, Martin, and Graham

Appellants rely on the same arguments previously raised for claim 1 and assert that Graham adds nothing to the combination of Puskala and Martin that would have made the subject matter of these claims unpatentable (Br. 17; Reply Br. 7-8). Additionally, Appellants contend that even if Graham taught using “tokens,” the combination is still improper since Puskala teaches away from customization of its predefined messages (Reply Br. 8). As discussed above with respect to claim 1, Puskala does allow the user modifications to the predefined messages and therefore, may properly be combined with Martin and Graham to benefit from minimized text entry as a result of using tokens.

Therefore, in light of our findings above, we find that the teachings of Puskala and Martin combined with Graham suggest the subject matter of Claims 9-12, 25-28, and 38-40.

CONCLUSION OF LAW

Because Appellants have failed to point to any error in the Examiner’s position, we sustain the 35 U.S.C. § 103 rejection of claims 1-3, 7, 8, 13-19, 23, 24, 29-34, and 37 over Puskala and Martin and of claims 9-12, 25-28, and 38-40 over Puskala and Martin, and in view of Graham.

DECISION

The decision of the Examiner rejecting claims 1-3, 7-19, 23-34, and 37-40 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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